

REMARKS

Reconsideration of the Office action mailed January 25, 2006 in connection with the above-identified patent application is requested in view of the following remarks.

Claim Rejections – 35 U.S.C. § 103

I. Rejection of claim 20 based on Yoneda, Mowery and Razzano.

The examiner rejected claim 20 under 35 U.S.C. 103(a) in light of Yoneda (US Patent 4,117,752) combined with Mowery (US Patent 2,785,710) and Razzano (US Patent 6,564,909). That rejection is traversed.

Claim 20 describes a woodworking machine with a cutting tool for cutting workpieces. The machine has a detection system adapted to detect a dangerous condition between a user and the cutting tool and a reaction system adapted to disable the cutting tool when the detection system detects the dangerous condition. A control system is adapted to monitor the detection system and control actuation of the reaction system. The control system is further adapted to test at least a portion of the reaction system to verify that the portion of the reaction system is operational without having to operate the reaction system.

Yoneda discloses a band saw configured to detect when a person comes into contact with the blade. The saw includes an electromagnetic brake to decelerate the motor and an electromagnetic clamp brake to clamp the sides of the blade if a person touches the blade. The examiner says Yoneda's band saw is a woodworking machine with detection and reaction systems as recited in claim 20, but the examiner recognizes that Yoneda does not disclose a control system "adapted to test at least a portion of the reaction system to verify that the portion of the reaction system is operational without

having to operate the reaction system.” The examiner cites Mowery and Razzano to show such a control system. Mowery discloses a brake for a power saw that includes brake shoes to press against the side of the blade. Razzano discloses a wear detector for a vehicle braking member. The examiner says it would have been obvious to modify the band saw of Yoneda to include a brake as shown in Mowery and a wear detector as disclosed in Razzano.

This rejection should be withdrawn because: 1) Razzano is not prior art, 2) Razzano is non-analogous art, 3) the cited references fail to teach or suggest all claim limitations, and 4) there is no suggestion to combine the references. These are independent reasons why the obviousness rejection should be withdrawn.

1. Razzano is not prior art.

Razzano is not prior art because the invention of claim 20 was prior in time to Razzano’s filing date. Applicant is submitting a declaration under 37 CFR 1.131 of Dr. Stephen F. Gass to swear behind the Razzano patent. In that declaration Dr. Gass explains that he invented the subject matter of claim 20 at least by February 16, 2000, the date on which he filed the later of two provisional patent applications disclosing the subject matter of claim 20. Thus, Razzano is not prior art because the Razzano patent was granted on an application filed in the United States after applicant’s invention.

2. Razzano is non-analogous art.

Even if Razzano were prior art, it still should not be considered because it is outside the proper scope and content of the art. In other words, Razzano is outside the field of applicant’s endeavor and is not pertinent to the particular problem addressed by applicant’s invention, so it should not be considered in an obviousness analysis. The

Federal Circuit has explained: "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (citation omitted); see also MPEP 2141.01(a). The field of applicant's endeavor is woodworking equipment while the field of Razzano's endeavor is vehicle brakes. Clearly, these fields are different. Therefore, Razzano can only be considered if it is reasonably pertinent to the particular problem addressed by applicant's invention.

The Federal Circuit explained how to determine whether a reference is reasonably pertinent in the case of In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058 (Fed. Cir. 1992). In that case, the Federal Circuit reversed a rejection of claims to a process for storing liquid hydrocarbon in a tank having a dead volume between the bottom of the tank and its outlet. Id. at 657. The process included the step of placing gel in the dead volume. The claim was rejected in light of two references: Hetherington, which disclosed a petroleum storage tank that used bladders to fill the dead space at the bottom of the tank, and Sydansk, which taught using gel to fill anomalies in underground petroleum formations. The Patent Office ruled that Clay's invention was obvious in light of the combination of these two references.

Clay appealed the rejection and argued that Sydansk should not have been considered because it was non-analogous art; i.e., Sydansk was art from a different field of endeavor and not reasonably pertinent to the problem of removing dead space from storage tanks. The Federal Circuit agreed and reversed the rejection. The Federal Circuit explained that Sydansk was not within the field of Clay's endeavor because Clay

concerned the *storage* of refined liquid hydrocarbons while Syndask concerned itself with the *extraction* of crude petroleum. Id. at 659. The court then considered whether Syndask was reasonably pertinent to the problem addressed by Clay. In answering that question, the court set forth the following rule and analysis:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058 (Fed. Cir. 1992).

The Federal Circuit then applied that standard and explained that the purpose of Clay was to displace liquid from dead spaces in a storage tank while the purpose of Syndask was to recover oil from rock. The court also explained that a subterranean formation "is not structurally similar to, does not operate under the same temperature and pressure as, and does not function like Clay's storage tanks." Id. at 660. Therefore, the court ruled that Syndask was not reasonably pertinent and reversed the rejection.

The situation in Clay is similar to the case at hand. The purpose of applicant's invention is to minimize the chance that a person could be severely injured by a cutting tool in a woodworking machine. In contrast, Razzano set forth the purpose of his invention as follows: "to provide a wear detector for a vehicle braking member." (Razzano, column 1, lines 23-24.) Razzano's invention can be used, for example, to monitor brake pads on a car. These are distinctly different purposes.

Woodworking machines and vehicles are also different structurally and functionally. A woodworking machine as set forth in applicant's claim 20 includes a cutting tool, a detection system to detect a dangerous condition between a user and the cutting tool, and a reaction system to disable the cutting tool, none of which is found in a vehicle brake system. Vehicle brake systems have brake calipers, brake pads, brake disks, and other components not found in woodworking machines. Woodworking machines typically operate by spinning some type of cutting tool, and the function of a woodworking machine is to cut or shape a workpiece. Vehicles operate by a motor driving a drive shaft and wheels, and the function of a vehicle is to transport people and goods from one location to another.

Thus, woodworking machines and vehicles have different purposes, structures, operations and functions. Because of these differences, Razzano would not have logically commended itself to a person considering how to minimize the chance of injury from a cutting tool in a woodworking machine. The situation at hand is the same as the situation in Clay; different purposes, structures, operations and functions show that vehicles and vehicle brake systems are not pertinent to woodworking machines, just as different purposes, structures, operations and functions showed that extracting oil from subterranean formations was not pertinent to storing hydrocarbon liquid in storage tanks. Razzano should not be considered in this obviousness inquiry just as the Sydansk reference was not considered in Clay.

The case of In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992), further explains when a reference is analogous art that may be considered in an obviousness analysis. In that case, the Federal Circuit reversed a rejection of claims to a hose clamp having a hook

to maintain a preassembly condition of the clamp. The Patent Office had rejected the claims based on the combination of an earlier patent to Oetiker disclosing the clamp without the hook and a patent to Lauro describing a plastic hook and eye fastener used in garments. Id. at 1446.

The Federal Circuit explained:

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. Id. at 1447.

This analysis from Oetiker applies to the case at hand. The Patent Office has not shown that a person of ordinary skill in the art of designing woodworking machines, seeking to minimize the chance that a person could be severely injured by a cutting tool, would be expected or motivated to look to brake systems for vehicles, just as the Patent Office in Oetiker failed to show that a person of ordinary skill seeking to solve a problem

of fastening a hose clamp would look to the garment industry for fasteners. It is only with the benefit of hindsight - with knowledge of applicant's invention - that one would consider combining elements from vehicles with woodworking machines to arrive at applicant's claimed invention, just as it was only with hindsight that one would consider combining elements from garments with hose clamps. That use of non-analogous references is error in the present application just as it was error in Oetiker.

In re Pagliaro, 657 F.2d 1219, 210 USPQ 888 (CCPA 1981), is another case which illustrates this point. The invention in that case involved a process for preparing decaffeinated beverages. The invention used edible fats to extract the caffeine while the prior art used potentially toxic solvents. Id. at 1220. The examiner rejected the claims as obvious in light of a patent to Nutting combined with either a patent to Rector or an article by Aeillo. Nutting taught the conventional process of using solvents. Id. at 1221. Rector disclosed a method of making coffee by grinding coffee beans with oil and then extracting the oil, and Rector said the extracted oil was more heavily charged with the stimulative elements of the coffee. Id. Aeillo discussed the lipoid theory of narcotics, and specifically, the solubility of narcotics in fatty oils. Id. at 1221-1222. The Board of Patent Appeals and Interferences affirmed the rejection and Pagliaro appealed.

On appeal, the Court of Customs and Patent Appeals reversed the rejection because the Board misinterpreted Rector and because Aeillo was a non-analogous reference. The court's discussion of Aeillo is particularly relevant to the case at hand. The court explained:

We regard Aeillo as nonanalogous art, which cannot properly be considered pertinent prior art under 35 U.S.C. 103. In In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (Cust. & Pat. App.1979), this court stated: "In resolving the question of obviousness under 35 U.S.C.

s 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. (Citation omitted.) The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts."

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Both the instant claims and Nutting involve decaffeination of vegetable materials; whereas, Aeillo compares the solubility of a diuretic solution, such as a caffeine solution combined with an oil/serum mixture, to the same solution combined with an oil/water mixture. He determines that caffeine is "more soluble in serum than in water." From this he concludes that the Meyer/Overton lipoid theory of narcotics, which was based upon experiments using an oil/water mixture, is inaccurate because an oil/water mixture does not approximate the substances found in the human body. Thus, Aeillo's disclosure is not "within the field of the inventor's endeavor." Further, Aeillo is not pertinent to appellants' problem because he is not concerned with either beverage preparation or decaffeination of vegetable materials. There is no common environment which could form a "close relationship" between either the claimed invention or Nutting on the one hand and Aeillo on the other to logically require consideration of Aeillo. In re Antle, 58 CCPA 1382, 1387, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (1971). An earlier statement by this court in In re Van Wanderham, 54 CCPA 1487, 1494, 378 F.2d 981, 988, 154 USPQ 20, 25 (1967), is particularly appropriate: "Our determination here is not without difficulty. However, we think the difficulty arises from not considering the subject matter as a whole and instead focusing on the scientific principle involved"

In this case, the board erred by focusing on the affinity of olive oil for caffeine without considering the subject matter of Aeillo as a whole and the impropriety of the Aeillo reference, as pointed out above. (Pagliaro, 657 F.2d at 1224-1225.)

In the case at hand, the examiner did not consider Razzano as a whole, just at the board in Pagliaro did not consider the Aeillo reference as a whole. Instead, the

examiner simply focused on the fact that Razzano disclosed a system to monitor the thickness of a brake pad in a vehicle. (Final Office Action, 3.) When Razzano is considered as a whole, the differences between a woodworking machine and a vehicle brake system become apparent. There simply is no "common environment which could form a 'close relationship'" between woodworking machines and vehicle brakes, just as there was no such common environment between the decaffeination of vegetable materials and the solubility of a diuretic solution in Pagliaro.

3. The cited references fail to teach or suggest all claim limitations.

Even if Razzano were prior art and reasonably pertinent to applicant's invention, which it is not, Razzano still fails to disclose a control system as recited by claim 20, and therefore, claim 20 cannot be obvious in light of the cited references. See, e.g., 35 USC 103(a) (question is whether "the subject matter *as a whole* would have been obvious"); Application of Royka, 490 F.2d 981, 985 (CCPA 1974) (claim not obvious because limitation missing from cited references); Application of Wilson, 424 F.2d 1382, 1385 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."); Manual of Patent Examining Procedure, 2143.03 [hereinafter MPEP] (8th Ed., latest revision Oct. 2005) ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.")

On page 3 of the Office action mailed January 25, 2006, the examiner says:

Razzano also teaches a control system 32 configured to determine the operability of the reaction system without having to operate the reaction system. It should be noted that the wear of the brake pad 1 or the friction block 8 is monitored by the control system 32 at all times which also includes the time that the reaction system in [sic] not operating. See col. 1, lines 15-20 and col. 3, lines 1-50.

The examiner is mistaken about the operation of Razzano. Razzano's detector determines the status of brake pad 1 only if the brake is operated. It does not and cannot determine the status of the brake pad if the brake is not operated.

The brake disclosed in Razzano works to decelerate a vehicle when a block 8 of friction material slides against a metal brake disk 2. A detector 14 with a resistive element 26 extends through block 8. The resistive element is simply a metal wire with a free end surface 35 (also called electric terminal 35) terminating at a surface 10 of the block 8 adjacent the brake disk, and the other end of the wire (called electric terminal 30) connected to a control unit 32. (Razzano, column 2, lines 19-58.) Because terminal 35 is coplanar with surface 10 of block 8, electric terminal 35 contacts the metal brake disk during braking, causing terminal 35 to be at the same electric potential as the brake disk. A control unit 32 then determines the thickness of block 8 by detecting the difference between the potentials at terminals 30 and 35, as well as the relative current flow through element 26.

The difference in potential and the relative current flow through resistive element 26 depend on the resistance of element 26. That resistance, in turn, depends on the length of the element. Over time, block 8 and resistive element 26 are worn down due to the friction from braking. As resistive element 26 is consumed, it becomes shorter and its electric resistance changes, resulting in different potentials and different current flows. The control unit interprets those different potentials and current flows as different thickness measurements. Razzano explains the operation of his system as follows:

Electric terminal 35 therefore changes position as element 26 is consumed, and is set to the same potential as brake disk 2 when surface 10 and, therefore, terminal 35 itself are positioned contacting brake disk 2; whereas terminal 30 is set to a reference potential by

central control unit 32. By determining the difference in potential between terminals 30 and 35 and the relative electric current flow in circuit 37, central control unit 32 determines the electric resistance value of element 26 and, therefore, the thickness of block 8 of friction material on the basis of the shape and length of element 26. (Razzano, column 3, lines 18-28.)

Razzano's system, however, requires terminal 35 to contact brake disk 2 to measure the thickness of the brake pad; the system cannot determine the thickness of the brake pad if terminal 35 is not in contact with the brake disk. Therefore, Razzano's system can determine the thickness of the brake pad only if the brake is operated. Razzano's statement that his system determines the wear of the brake pad "as continuously as possible throughout the working life of the braking member" (Column 1, lines 18-19) does not mean that the system can detect thickness without operating the brake. It simply means that the system monitors the brake pad continuously as the pad is consumed, not simply after the pad has worn down to a predetermined thickness.

Thus, Razzano fails to teach or suggest any control system "adapted to test at least a portion of the reaction system to verify that the portion of the reaction system is operational without having to operate the reaction system," as required by claim 20.

4. There is no suggestion to combine the references.

Even if Razzano were prior art and analogous, which it is not, and even if Razzano disclosed a control system as required by claim 20, which it does not, there still would have to be some teaching, suggestion, or motivation to combine Yoneda, Mowery and Razzano in order to render claim 20 obvious. In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998). In the case at hand, there is no such suggestion.

The only suggestion identified by the examiner to combine the references is the following:

It would have been obvious to a person of ordinary skill in the art to provide Yoneda's woodworking machine, as modified by Mowery, with the control system, as taught by Razzano in order to monitor the brake shoes and detect the wear of the brake shoes and prevent possible injuries. (Office action mailed 1-25-06, p. 3.)

There is no support in the cited references for the examiner's conclusion. Where does the prior art identify a reason to automatically monitor brake shoes in woodworking equipment? It is important to understand that the mere existence of a wear detector for vehicles as disclosed in Razzano does not mean it would have been obvious to use such a detector in a woodworking machine. The cited references make no such suggestion. The only teaching or suggestion to include a control system as recited in claim 20 in a woodworking machine is found in applicant's teachings. If one has not reviewed applicant's disclosure, there would be no reason to include such a control system in a woodworking machine; one would use systems like those disclosed in Yoneda or Mowery instead. In an obviousness analysis, however, one must review the prior art without the benefit of applicant's disclosure. One cannot use the teaching of applicant's disclosure to suggest the modification to the prior art. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted), *abrogated on other grounds* in In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000).

The examiner's statement that the suggestion to combine references could come from the desire to "prevent possible injuries" is not a sufficient motivation to combine references. If it were, then almost no safety improvement could be patented because there is always a desire for safer products. Rather, there must be some specific

understanding or technological principle in the prior art suggesting the specifically claimed combination. Expressed differently, it is not the desire to make something better but the solution that must be suggested or taught, and that suggestion must be clear and particular. In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998). In the case at hand, the examiner failed to identify any specific suggestion to make the combination.

II. Rejection of claims 1, 11, 21, 28 and 30 based on Yoneda, Mowery, Razzano and Doherty.

The examiner rejected claims 1, 11, 21, 28 and 30 under 35 U.S.C. 103(a) in light of Yoneda combined with Mowery, Razzano and Doherty (US Patent 6,325,195). The examiner says Yoneda, when modified by the teachings of Mowery and Razzano, discloses a woodworking machine as claimed, except that Yoneda as modified “does not teach that the control system disables the motor if the reaction system is not operable.” (Office action mailed 1-25-06, p. 4.) The examiner cites Doherty as disclosing a control system that disables a motor. That rejection is traversed.

This rejection should be withdrawn for the same reasons given above concerning claim 20, i.e., Razzano is not prior art, Razzano is non-analogous, the cited references fail to disclose or suggest all claim limitations, and there is no suggestion to combine the references. This rejection also should be withdrawn because: 1) Doherty does not teach or suggest a control system as claimed, 2) there is no reasonable expectation of success, and 3) there is no suggestion to combine Doherty with the other references.

1. Doherty does not teach or suggest a control system as claimed.

Doherty discloses panels that can be positioned around a machine to form a safety barrier. The panels can be rolled up or raised to allow access to the machine. When a panel is raised, "it pulls male plug 74 out of female plug 72 and breaks the circuit along line 82, thereby shutting off motor 80." (Doherty, column 3, line 67 to column 4, line 2.) Additionally, Doherty discloses an open switch 36 to cause a panel to roll up, and the open switch can "cause electrical power 40 to machine 44 to be shut off." (Doherty, column 4, lines 46-47.) The panels also may include safety interlock switches to prevent the machine from operating when the panels are open. (Doherty, column 4, lines 58-63.) The plugs and switches disclosed by Doherty are not the same as the reaction and control systems recited in applicant's claims because those plugs and switches do not disable a motor if a reaction system is inoperable. They simply open a circuit when a panel is raised.

2. There is no reasonable expectation that the combination would succeed.

Even if the cited references disclosed all the limitations in the claims and suggested their combination, there still would have to be a reasonable likelihood that the combination would succeed. In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d (Fed. Cir. 1988) ("The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art."); see also MPEP 2143.02 ("Reasonable Expectation of Success Is Required"). The obviousness rejection cannot stand without that expectation. Id. In the case at hand, there is no reasonable expectation that Yoneda,

Mowery and Razzano could be successfully combined with Doherty because Doherty's plugs and switches require rolling up a panel to unplug the plugs or open the switches. There simply is no teaching as to how Doherty's plugs and switches could be used to disable a motor if a reaction system was inoperable in a woodworking machine.

3. There is no suggestion to combine Doherty with the other references.

The only suggestion identified by the examiner to combine Doherty with the other references is "[b]ecause, simultaneously shutting down the motor and generating a warning signal improve the reaction system and safety of the machine." In other words, the examiner is saying the combination is suggested because it is better. But the simple desire for improved products cannot by itself constitute a suggestion to combine references. If it did, then no improvement would be patentable because there is always a desire for improved products. Rather, there must be some express or implicit teaching, suggestion or motivation found in the prior art, or in the knowledge generally available to a person of ordinary skill in the art, to make the specifically claimed combination. In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998).

III. Rejection of claims 2, 3 and 31 based on Yoneda, Mowery, Razzano, Doherty and Balban.

The examiner rejected claims 2, 3 and 31 under 35 U.S.C. 103(a) in light of Yoneda combined with Mowery, Razzano, Doherty and Balban (US Patent 3,863,208). Balban discloses a circuit for controlling the operation of a passive restraint system in a vehicle. This rejection is traversed for the same reasons given above concerning the other rejections. This rejection is also traversed because: 1) Balban is outside the

proper scope and content of the art, 2) there is no suggestion to combine Balban with the other references, and 3) Balban does not disclose all the limitations of claim 31.

1. Balban is outside the proper scope and content of the art.

The field of Balban's endeavor is vehicle safety systems while the field of applicant's endeavor is woodworking equipment. Balban is not reasonably pertinent to the particular problem addressed by applicant's invention because woodworking machines and vehicle safety systems have different purposes, structures, operations and functions. In re Clay, 966 F.2d 656, 660, 23 USPQ2d 1058 (Fed. Cir. 1992). The purpose of Balban's system is to enhance the safety of a person in the vehicle during a crash. The structure of the system includes sensors to detect rapid deceleration of the vehicle, firing squibs or detonation coils, pressurized gas reservoirs, and expandable chambers or airbags. When the sensors detect rapid deceleration of the vehicle, the system operates by firing the squibs to release the pressurized gas to inflate the airbags. The function of Balban's system is to restrain movement of vehicle occupants by inflating airbags. In contrast, a woodworking machine as set forth in a number of applicant's claims includes a cutting tool, a motor to drive the cutting tool, a detection system to detect a dangerous condition between a person and the cutting tool, and a reaction system to disable the cutting tool, none of which is found in Balban's system. Woodworking machines typically operate by spinning some type of cutting tool and the function of a woodworking machine is to cut or shape a workpiece. Because of these differences, Balban would not have logically commended itself to applicant's attention in considering how to minimize the chance that a person could be severely injured by a cutting tool in a woodworking machine, and as a result, Balban is non-analogous art.

2. There is no suggestion to combine Balban with the other references.

The examiner said the suggestion to combine Balban with the other references was the following:

It would have been obvious to one skilled in the art at the time of the invention to equip Yoneda's reaction system, as modified above, with the capacitor and fuse, as taught by Balban, in order to disable the cutting tool with an electric circuit that can be monitored for malfunctions and consequently enhance the safety system of the cutting tool. (Office action mailed 1-25-06, p. 7.)

In other words, the examiner says the combination would have been obvious because it results in a better safety system for cutting tools. But, as stated previously, the simple desire for a better system cannot by itself constitute a suggestion to combine references. If it did, then no improvement would be patentable because there is always a desire for improved products. Rather, there must be some express or implicit teaching, suggestion or motivation found in the prior art, or in the knowledge generally available to a person of ordinary skill in the art, to make the specifically claimed combination. In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998).

Concerning the capacitors and controls systems recited in claims 2 and 3, and the reaction system and control system recited in claim 31, the only teaching or suggestion to include such limitations in a woodworking machine comes from applicant's teachings. If one has not reviewed applicant's disclosure, there would be no reason to include such limitations in a woodworking machine; one would use systems like those disclosed in Yoneda or Mowery instead. In an obviousness analysis, however, one must review the prior art without the benefit of applicant's disclosure. One cannot use the teaching of applicant's disclosure to suggest the modification to the prior art. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)

(citations omitted), *abrogated on other grounds* in In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000).

3. Balban does not disclose all the limitations of claim 31.

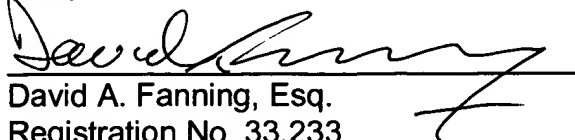
Claim 31 recites "a fusible member and where the control system is configured to determine the condition of the fusible member." The examiner says "Balban also teaches that reaction system includes a fusible member F1-F4 and where the control system is configured to determine the condition of the fusible member," and that Balban's system inherently determines the condition of the fusible member by monitoring the "whole electric circuit for malfunctioning." (Office action mailed 1-25-06, p. 6.) However, monitoring the electric circuit generally is not the same as determining the condition of a fusible member, as is evident from the fact that the circuit may malfunction without indicating the condition of the fusible member.

Conclusion

Applicant submits that all of the issues raised in the Office action mailed January 25, 2006 have been addressed and overcome, and therefore, the application should be allowed.

Respectfully submitted,

SD3, LLC

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Date: April 25, 2006

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